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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/903,230 | 07/11/2001 | William Andrus Williams | 02410-0110<br>(42353-211537) | 9481 |

7590 11/21/2002

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| EXAMINER |
|---|
| NUTTER, NATHAN M |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1711 | 6 |

DATE MAILED: 11/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/903,230 | WILLIAMS ET AL. | |
| | Examiner | Art Unit | |
| | Nathan M. Nutter | 1711 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-37* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-37* are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4,5* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

## DETAILED ACTION

The restriction requirement made on 4 October 2002 by Examiner Walter Aughenbaugh to attorney Jeffrey B. Arnold is hereby expressly vacated in view of the following newly stated restriction requirement.

In applicants' original disclosure, as filed, on page 16, claim 30 repeats before claim 32. in accordance with Rule 126, these and the claims following have been renumbered as follows: claims 30, 32-36 are now numbered as claims 32-37, inclusive. The following restriction is being made with those claims as renumbered.

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-18, drawn to a "method of making an elastomeric formulation", classified in class 525, subclasses 192, 193, 194 and 196.

II. Claims 19-23, 34 and 35, drawn to a method of using an "elastomeric material (to form) a latex article", classified in classes 264 and 427, subclasses vary according to class.

III. Claim 24, drawn to a glove made from an elastomeric material, classified in class 428, subclasses 34.1+.

IV. Claims 25 and 26, drawn to a "method of making a latex article", classified in classes 264 and 427, subclasses vary according to class.

V. Claims 27-33, drawn to an elastomeric material, classified in class 525, subclasses 192, 193, 194 and 196.

VI. Claims 36 and 37, drawn to a polymer formulation with additives, classified in class 524, subclasses vary.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are all methods which produce different results. Group I produces an elastomer, Group II produces an elastomeric article and Group IV produces a latex article. The several Groups, as listed, fail to claim the same or corresponding special technical features. The inventions are not disclosed as being capable of use together and possess different characteristics which have different functions and effects, as well as have different modes of operation. The groupings of claims which would be acceptable to provide a Unity of Invention are those as set out in 37 CFR 1.475(b). Note MPEP 1875.01 in this regard.

Inventions III, V and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions each of the groups is drawn to a separate and patentably distinct article. Group III is drawn to a glove, Group II is drawn to an elastomeric material and Group VI is drawn to a polymer formulation. The several

Groups, as listed, fail to claim the same or corresponding special technical features. The inventions are not disclosed as being capable of use together and possess different characteristics which have different functions and effects, as well as have different modes of operation. The groupings of claims which would be acceptable to provide a Unity of Invention are those as set out in 37 CFR 1.475(b). Note MPEP 1875.01 in this regard.

Inventions of Groups II and III are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a shoe sole as evidenced by Otawa et al (USPN 4,818,785) and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Due to the complexity of the restriction requirement, applicants' counsel was not contacted telephonically to request an oral election to the above restriction requirement. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 703-308-2443. The examiner can normally be reached on Monday-Friday 9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 703-308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Nathan M. Nutter
Primary Examiner
Art Unit 1711

nmn
January 28, 2003